

REMARKS

Claims 1, 5, 8, 9, 11, 12, 16, 19, 20, and 29 are pending in the application. Claim 1 was amended to more particularly claim the invention and claims 10, 24, 27, and 28 were cancelled. Claim 29 has been added and is supported by the language on page 2, lines 4-6 of the specification. No new matter has been added by way of this amendment.

Claims 1, 5, 8-12, 16, 19-20, 24, 27-28 stand rejected under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 6,391,400 to Russell et al. (hereinafter "Russell") in view of United States Patent No. 3,810,815 to Welhart et al. (hereinafter "Welhart"). The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the thickness of the base layer substrate of both Russell and Welhart.

In the present invention, Applicants sought to solve problems in prior art outdoor window films such as insufficient surface hardness and impact resistance as well as preventing the scattering of broken glass fragments (page 3, lines 7-25 of the specification). While addressing these problems, Applicants discovered the presently claimed hard coat film, which is applied to the external surfaces of windowpanes.

Russell discloses thermal control films comprising (a) a thin flexible polymeric sheet having a first face and an opposite second face and a thickness of from 0.1 to 100 mils; and, (b) a multilayer coating adhered to said first face, said coating comprising two or more contiguous alternating layers of high and low index of refraction inorganic dielectric material. Russell fails to teach the present invention's claimed base thickness and resin combination.

Welhart discloses a transparent laminate formed by diffusion bonding at least one layer of acrylic resin sheet to a layer of polycarbonate resin to form a clad polycarbonate. Welhart does not disclose applying the laminate to glass.

Claim 1 was amended by incorporating the limitations of claim 10 to more particularly claim the invention. The limitation that "the hard coat film is applied to the external surfaces of window panes or plastic boards for windows" renders the amended claim as being clearly distinguishable from Welhart. Additionally, Russell fails to disclose the base thickness and resin combination of the present invention. There is no motivation to combine the references to arrive at the amended claims. Therefore, the rejection under 35 U.S.C. § 103(a) based on Russell in view of Welhart should be withdrawn.

Claims 1, 5, 8-12, 16, 19-20, 24, 27-28 stand rejected under 35 U.S.C. 103(a) as being obvious over United States Patent No. 5,956,175 to Hojnowski (hereinafter "Hojnowski") in view of Welhart and United States Patent No. 6,103,370 to Onozawa et al. (hereinafter "Onozawa"). The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to have modified the thickness of the base layer substrate of both Hojnowski and Welhart. Additionally, it would have been obvious to provide Hojnowski with a release liner as taught by Onozawa and provide a silicone-based hard coat layer as also taught by Onozawa.

Under 35 U.S.C. 103(c), an applicant's admission that subject matter was developed prior to applicant's invention would not make the subject matter prior art to applicant if the subject matter qualifies as prior art only under sections 35 U.S.C. 102(f) or 35 U.S.C. 102(g), or, for applications filed on or after November 29, 1999, 35 U.S.C. 102(e), and if the subject matter and the claimed invention were commonly owned at the time the invention was made. MPEP 706.02(I)(2)

STATEMENT OF COMMON OWNERSHIP

The present Application No. 09/894,371 and United States Patent No. 6,103,370 were, at the time the invention of the present application was made, owned by Lintec Corporation, Tokyo, Japan.

This statement alone is sufficient evidence to disqualify United States Patent No. 6,103,370 from being used in a rejection under 35 U.S.C. 103(a) against the claims of the present application.

Applicants request that United States Patent No. 6,103,370 to Onozawa be removed as a reference since it and the present application were commonly owned at the time the present invention was made by Lintec Corporation in Tokyo, Japan.

Hojnowski discloses a solar control window film having high visible light transmission and low transmission of near infrared heat energy. The film includes a transparent substrate bearing a thin, optically transparent layer of metal, an optically transparent layer of near infrared energy absorbing material, and a transparent layer of protective material overlying and protecting the near infrared energy absorbing material and the metal.

Hojnowski does not teach the same thickness of the multi-layered base as in the present invention, nor does Hojnowski teach the same specific resins. The purpose of having the multi-layered base no thicker than 350 μm is to provide a hard coat film that can be easily stuck onto windowpanes, plastic boards, etc. However, if the thickness were as large as the secondary references, it would be difficult to stick the sheet onto windowpanes, etc.

Claim 1 was amended by incorporating the limitations of claim 10 to more particularly claim the invention. The limitation that "the hard coat film is applied to the external

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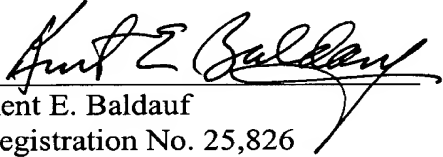
surfaces of window panes or plastic boards for windows” renders the amended claim as being clearly distinguishable from Welhart. As Welhart is no longer relevant to the amended claims and Onozawa has been removed as a reference, there is no modifying reference to combine with Hojnowski to reach the amended claims. Therefore, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of claims 1, 5, 8, 9, 11, 12, 16, 19, 20, and 29 is respectfully requested.

Respectfully submitted,

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